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09/802,957	03/12/2001	Gary B. Robinson	11032/3022	4809

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,957

Applicant(s)

ROBINSON, GARY B.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-11 have been examined.

Response to Amendment

2. The Amendment filed on 1/7/05 is sufficient to overcome the prior rejection utilizing the Dedrick reference alone. A new reference has been added to the Rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (5,724,521) in view of Roth (6,285,987).

Claim 1-4: Dedrick discloses a method for targeting advertising, including:
storing advertisement targeting information on a client (col 7, lines 15-25); and
selecting an advertisement for display based upon the advertisement targeting information stored at the client (col 10, lines 45-63).

Dedrick does not explicitly disclose that the advertisement is selected at the client for display.

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However, Dedrick discloses that the client system can be flexible, take a wide variety of forms, and be distributed separately or as part of the same client system (Fig. 1; Fig. 2; col 6, lines 32-55).

Hence, the appraisal agent that selects the advertisements can be operate within or at the client system (Fig. 2, item 12) or as separate from the client interface (Fig. 2, item 23; col 6, lines 32-55).

Additionally, Dedrick's metering server can function as a client and select an advertisement for display to the user based upon the advertisement targeting information stored at the client or metering server (col 18, lines 34-55; col 2, lines 57-58; col 17, lines 15-20).

Dedrick further discloses the client controlling or influencing what or how advertisements are selected for display to the client (col 8, lines 40-52; col 10, lines 46-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Dedrick's advertisement can be selected at the client for display to the client. One would have been motivated to do this in order to provide better client control or flexibility in regards to the advertisements that are selected for the client.

Also, Dedrick further discloses receiving information provided by a client (col 9, lines 54-62; col 11, lines 9-14; Fig. 1; Fig. 2); selecting an agent based upon the information provided by the client (col 9, lines 62-67; col 10, lines 1-10; col 10, lines 45-55);

sending the selected agent to the client (col 9, lines 50-55; col 10, lines 59-64; Fig. 2, item 28), wherein the agent is adapted to select an advertisement at the client based upon information stored at the client (col 10, lines 45-63).

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Also, Dedrick discloses receiving information about a recipient (col 9, lines 54-62; col 11, lines 9-14; Fig. 1; Fig. 2); selecting an agent based upon the information received about the recipient (col 9, lines 50-54; col 9, lines 62-67; col 10, lines 1-10; col 10, lines 45-55);

sending the selected agent to a client (col 9, lines 50-55; col 10, lines 59-64; Fig. 2, item 28), wherein the agent is adapted to select an advertisement based upon private information stored at the client (col 10, lines 45-63).

Also, Dedrick discloses sending an agent to a client (Fig. 1; Fig. 2; col 9, lines 50-55; col 6, lines 45-50); receiving an advertisement request from an agent, wherein the request is based upon information stored at the client (col 10, lines 45-63); sending an advertisement to the client based upon the advertisement request (col 10, lines 45-63).

Additionally, Dedrick discloses that there can be multiple appraisal agent(s):

“(34) In one embodiment of the present invention, the client system 12 also includes an appraisal agent(s) 28. . . In one embodiment, multiple appraisal agents 28 may be initiated by a single end user, with each appraisal agent 28 performing a different search (col 9, line 48-65).

Dedrick discloses that the agent(s) can present advertisements to the user:

“(36) The appraisal agent 28 searches for information by making requests to the yellow page servers 22. These requests include the search criteria and are received by the session manager 78 of the yellow page server 22. Then, via the interactive process 76, session manager 78 accesses the advertising database 70 in an attempt to locate electronic information which matches the search criteria (col 10, lines 10-15);

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Thus, the appraisal agent 28 can access the advertisement in the yellow pages server 22, determine it matches the characteristics of the end user which initiated the appraisal agent, and return the advertisement to the end user (col 10, lines 39-45);

The appraisal agent may then return titles of 25 electronic advertisements to the end user, and allow the end user to select which advertisements he or she will consume" (col 10, lines 60-65).

Dedrick discloses that user(s) can be paid or pay for access to information/advertising:

"(60) In addition to debit models, the software tools may also allow the publisher/advertiser 18 to build a credit model which credits the end user's account each time the user views a unit of information. . . By way of example, the credit model can be used in association with the yellow pages content database. The publisher/advertiser may also be provided with a field that allows the publisher/advertiser to select between credit and debit" (col 13, lines 52-64).

Dedrick discloses that numerous parties can be involved in the costs of providing content:

"(69) The clearinghouse server 20 can also credit or debit the publisher/advertiser account for electronic information sent by another publisher/advertiser. For example, advertising information generated by an advertiser and viewed by an end user can be credited to the account of a publisher if the advertising information is associated with electronic information provided by the publisher" (col 15, lines 36-44).

Dedrick discloses a variety of pay structures for providing of content:

"(55) "Pay Per View" (56) "Pay Per Byte" (57) "Pay Per Time"" (col 13, lines 40-45).

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Dedrick further discloses charging more or less depending on how well advertisements match user characteristics:

“(12) In one embodiment, a consumer scale is generated for each of multiple electronic advertisements. These advertisements are then transferred to multiple yellow page servers, and the titles associated with the advertisements are subsequently transferred to multiple metering servers. At the metering servers, a determination is made as to where the characteristics of the end users served by each of the metering servers fall on the consumer scale. The higher the characteristics of the end users served by a particular metering server fall, the higher the fee charged to the advertiser” (col 2, lines 10-20);

(15) In one embodiment, the advertiser 18 selects how well the user profile characteristics of end users served by a metering server 14 must match the consumer scale in order for the advertiser 18 to pay the highest fee. Note that this highest fee may be a maximum established for the entire system 10, or may be a different maximum for each metering server 14 as established by each metering server 14 (col 5, lines 29-36);

(16) Additional prices between the highest and lowest available prices are also included in the scale” (col 5, lines 53-55).

Dedrick further discloses multiple publishers/advertisers/content providers (Fig. 1; col 1, lines 23-26; col 11, lines 15-17).

Dedrick does not explicitly disclose an auction or bidding for selection of an advertisement.

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However, Roth discloses an agent that bids for selection of advertising based on characteristics or profile of a user (Abstract; Fig. 1; Fig. 2b; Fig. 3; Fig. 7; and the below citations):

“(6) In general the system includes one bidding agent 30 for each proposed bid (see later discussion about multi-level bids). Each advertiser would have an associated bidding agent 30 for each ad campaign the advertiser wants to conduct. Advertisers submit proposed bid, to their associated bidding agents for evaluation against view-ops. Bidding agents 30 can be simple or complex and if desired they can have the ability to evaluate more than one proposed bid to determine what bid should be submitted to the bid selection logic 16C (col 4, lines 15-25);

(14) With the present invention, when a view-op arises, the bidding agents evaluate the characteristics of the view-op compared to the specifications in proposed bids and the bidding agents submit bids to the bid selection logic where appropriate. Next, the bid selection logic selects the highest bid from the various available bids and the advertisement which is specified in the highest bid is displayed. The novel aspect of the present invention is the organization, operation and interaction between the bidding agents, the server which provides information to the bidding agents, the bid selection logic and the associated mechanisms for presenting the advertisements (col 2, lines 54-65);

(10) (3) It compares various bids received from bidding agents 30 in order to determine which advertisement to display (col 4, lines 37-41);

(13) When a viewer 10 accesses web page 12, which has an HTML reference to server system 16, the present invention determines which advertisement from data base 16A to present

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to the viewer. The manner in which the system performs these operations is shown by block diagram 2B. For example, one advertiser might have submitted a proposed bid to bidding agent 30A which specified that he is willing to pay five cents for displaying an ad to a viewer who has accessed at least three financially oriented data bases within the last week. Another advertiser might have submitted a proposed bid to bidding agent 30B specifying that he is willing to pay six cents for displaying an advertisement to a viewer that has accessed at least three financially oriented data bases with the last five days. When a view-op occurs which is initiated by a viewer 10 who has accessed three financially oriented data bases in the last five days, bidding agents 30A and 30B would determine that the particular view-op satisfies the criteria specified by both advertisers. Both bids would be submitted to bid selection logic 16C and bid selection logic 16C would then select the highest bid and the advertisement specified by that advertiser would be displayed to the viewer. The criteria specified by the advertisers may be much more complex and involve many more parameters than those given in the simple example specified above. However, notwithstanding the complexity of the proposed bids and the number of parameters specified in each proposed bid, the operations performed by bidding agents 30 and by bid selection logic 16C are as explained in the above simple example (col 4, line 57-col 5, line 20);

(14) As shown in FIG. 2B, a cycle of operation begins (block 210) when a viewer 10 selects a web page 12 which has a HTML reference to web server system 16, that is, when a view-op occurs. It is noted that this occurs in real time and it can take place thousands of times per minute. Block 211 indicates that the web server system 16 sends information concerning the view-op and related information in the data base 16B to the bidding agents 30. The bidding

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agents 30 compare the information about the view-op to the proposed bids that have been submitted by advertisers. That is, the bidding agents 30 determine if the characteristics of the view-op meet the criteria in the proposed bids and if so they submit bids to bid selection logic 16C (block 213). As shown by block 214, the bid selection logic 16C compares various bids and selects the highest bid and therefore an advertisement for display. The appropriate advertisement called for by the winning bid is then sent from data base 16A to browser 11 (block 215)" (col 5, line 20-37).

Roth further discloses an auction held by computer to determine a winning bid associated with an advertisement (Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Roth's agent bidding for selection of an advertisement to Dedrick's utilization of agents and multiple advertisers paying varying fees in order to have an advertisement selected. One would have been motivated to do this in order to provide further features for better determining which advertisement/content to display when there are multiple advertisers and/or multiple content that can potentially be displayed.

Claims 5-11: Dedrick and Roth render obvious the independent method claims 1-4 above. Additionally, dependent claims 5-11 are rejected below.

Dedrick further discloses that the selected advertisement is displayed to the user (col 10, lines 40-45).

Roth further discloses that the selected advertisement is displayed to the user:

"(25) After receiving input from bidding agents 30 (that is from all the bidding agents 30 that submit bids) the bid selection logic 16C in view server 320 selects the highest bid and

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indicates to web server 310 which advertisement should be displayed in response to the view-op. In response to the input from view server 320, the web server 310 delivers the appropriate advertisement to the web client 11” (col 7, lines 19-25).

Dedrick further discloses that users who are possibly interested in an advertisement are of a higher value and, therefore, more can be:

“Thus, it would be beneficial to provide a system which allows electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements, and thus not require advertisers to provide an advertisement to the entire population, the majority of which may have no interest whatsoever in the product or service being advertised” (col 1, lines 50-56).

Dedrick further discloses that a binary determination (Yes or No) can be made as to whether to display content to a user or not based upon minimum criteria. That is, if content meets or exceeds a minimal match criteria, it is displayed (Yes). If the content is below a minimal match criteria, it is not displayed (No) (col 10, lines 45-55).

Dedrick discloses evaluating on a scale how well a user matches advertising targeting criteria and then reporting the evaluation in order to determine what content to display (col 18, lines 25-45; col 4, lines 58-65). It would be obvious to one skilled in the art that a content display determination can be made based on an evaluation score, as disclosed in Dedrick, and that the subsequent step of a fee being assigned to the score need not be performed. One would be motivated to do this in order to provide varying charging structures (including credit, debit, and no charge) for providing content.

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Dedrick and Roth disclose that the bids/charge can be in the form of money or fees as stated in the rejection of the claims 1-4 above. Dedrick further discloses that fees/charges for content can be in the form of money (col 13, lines 45-50).

Dedrick discloses that users can be tracked in their actions and that user actions can include viewing content and that these actions can determine a user profile that is utilized for targeting a user (col 7, lines 25-33; and above).

Roth discloses that the a bid can be requested upon the occurrence of an event such as the user moving to a different Web page (Fig. 2a; Fig. 2b).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Roth's tracking a user's current content viewing location to Dedrick's targeting a user and tracking user activities. One would have been motivated to do this in order to better target a user based on current user information.

Response to Arguments

4. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Also, on page 4 of the Applicant's Amendment dated 1/7/05, Applicant states that Dedrick does not disclose bidding related to advertisements. Please particularly note the new citations, reference, and explanations added in the rejection of the independent claims that starts with the section stating, "Additionally, Dedrick discloses that there can be multiple appraisal agent. . .".

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Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
7/26/05